

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No. 13051US03 (ITW matter 20410)

SECOND PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. No fee is believed due with respect to the Notice of Appeal because the Applicants previously paid the fee when the first Notice of Appeal was filed on March 9, 2007. See MPEP § 1207.04.

The review is requested for the reasons stated on the attached sheets.

Date: January 11, 2008 Respectfully submitted,
By: /Joseph M. Butscher/
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Attorney for Applicants

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REMARKS

The present application includes pending claims 21-26, 28 and 29. Claims 21-26 stand rejected. Claim 29 has been allowed, while claim 28 is objected to as being dependent upon a rejected base claim. Claims 21-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,411,287 (“Scharff”). Claims 24-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Scharff in view of United States Patent No. 6,492,978 (“Selig”).

The Applicants respectfully submit that the final Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims for a number of different reasons:

Claim 21 recites, in part, “an acoustic wave absorbing material **disposed between** the deformable dome and the touch sensitive surface,” of an acoustic wave switch “such that in response to a force acting on the dome, the dome deforms and contacts the absorbing material and the absorbing material contacts the touch sensitive surface of the acoustic wave switch with sufficient pressure to actuate the acoustic wave switch.” Claim 24 recites, in part, an “acoustic wave absorbing material being spaced from the touch sensitive surface of the acoustic wave switch when the actuator is in an unactuated position and the acoustic wave absorbing material contacting the touch sensitive surface of the switch actuating the acoustic wave switch in response to a force acting on the actuator to move the acoustic wave absorbing material into actuating contact with the touch sensitive surface of the acoustic wave switch.”

Scharff, alone or in combination with Selig, does not render claims 21-26 unpatentable. *See* December 13, 2007 Response at pages 5- 12. Initially, Scharff explicitly teaches away from an intervening acoustic wave absorbing material disposed between a seal and a touch screen. *See id.* at pages 6-7. Thus, for at least this reason, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims.

Next, the Applicants demonstrate that the portions of Scharff that the Office Action relies on as disclosing an acoustic wave absorbing material disposed between a deformable

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dome and a touch sensitive surface clearly do not describe, teach or suggest the relevant limitations. *See id.* at pages 7-12. Thus, for at least this reason, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims.

Further, the Office Action asserts that a Rayleigh wave (as disclosed in Scharff) is an absorbing material. *See* December 5, 2007 Office Action at page 6. The Applicants respectfully submit, however, that a Rayleigh wave is not a “material” that “absorbs itself,” as the Office Action contends. *See* December 13, 2007 Office Action at pages 8-10. For at least this additional reason, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims. Indeed, the Applicants even requested the Examiner to cite some authority that indicates that an acoustic wave is a **material** that absorbs itself. *See id.* at pages 8-9. However, the Examiner did not produce any such authority or evidence.

Additionally, the Applicants traversed the Examiner’s perceived assertion of Official Notice that “it is clear that the absorbing material is a Rayleigh wave or other wave.” *See id.* at pages 9-10. Despite being obliged to provide a reference in support of the perceived assertion of Official Notice (as per the MPEP), the Examiner failed to provide any such reference or evidence. Thus, for at least this additional reason, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims.

The Applicants demonstrate that the portions of Scharff relied on by the Office Action do not describe, teach or suggest the relevant claim limitations. *See id.* at pages 10-12. In short, none of the portions of Scharff relied on by the Office Action, nor anything else in Scharff, describes, teaches or suggests:

- an “acoustic wave absorbing **material disposed between** [a] deformable dome and [a] touch sensitive surface,” of an acoustic wave switch “such that in response to a force acting on the dome, the dome deforms and contacts the absorbing material and the absorbing material contacts the touch sensitive surface of the acoustic wave switch with sufficient pressure to actuate the acoustic wave switch,” as recited in claim 21.

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- an “acoustic wave absorbing material being spaced from the touch sensitive surface of the acoustic wave switch when the actuator is in an unactuated position and the acoustic wave absorbing material contacting the touch sensitive surface of the switch actuating the acoustic wave switch in response to a force acting on the actuator to move the acoustic wave absorbing material into actuating contact with the touch sensitive surface of the acoustic wave switch,” as recited in claim 24.

For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims.

The Applicants respectfully submit that the pending claims of the present application define patentable subject matter, and request reconsideration of the objections and rejections. The Applicants also note that the present application has been **pending for over seven years** (*i.e.*, filed November 20, 2001). The application has gone through extensive prosecution, and prosecution was previously reopened after a first Pre-Appeal Brief Request for Review. *See* April 2, 2007 Notice of Panel Decision. As such, the Applicants respectfully request that the application be allowed at this point, instead of prosecution merely being reopened.

As indicated above, **no fee is believed due with respect to the accompanying Notice of Appeal because the Applicants previously paid the fee** when the first Notice of Appeal was filed on March 9, 2007. *See MPEP § 1207.04.* The Commissioner is authorized, however, to charge any necessary fees, or credit any overpayment to Account No. 13-0017.

Respectfully submitted,

Dated: January 11, 2008

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